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Martin Churchill Trively

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MOORE AND VAN ALLEN PLLC FOR SEMC

P.O. BOX 13706

430 DAVIS DRIVE, SUITE 500

RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

GARTLAND, SCOTT D

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/707,638	Applicant(s) TRIVELY, MARTIN CHURCHILL	
	Examiner SCOTT D. GARTLAND	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) 4, 13, 15, and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03-14-2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status

1. This communication is in response to the application filed on December 29, 2003. Claims 1-27 are pending and presented for examination.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on March 14, 2007 was filed after the mailing date of the application on December 29, 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

3. Claims 4, 13, and 22 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims indicate the limitation of the offer code data defining the format and content of an entry, and the Examiner understands that when a promotional offer is sent, it must indicate with the offer the defined format and content required for entry - otherwise it would not be a valid offer, but just a suggestion. Therefore, since the promotional offer code data is previously required these claims do not further limit their respective parent claims.

4. Claim 15 is objected to as being of improper dependent form because the claim is directed to a mobile phone (within the statutory class of machine or article of manufacture), whereas the parent claims are directed to a method (the statutory class of a process). It may be possible to infringe claim 15 without infringing the method claims claim 15 depends from. The Examiner suggests amending the claim to direct it to the "method of claim 14."

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-3, 10-12, and 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "pre-provisioned" is used (second element of claims 1, 10 and 19; lines 1-2 of claims 2-3, 11-12, 20-21), but the Examiner is uncertain what the provisioning is prior to: is it prior to phone use, prior to providing the phone, or prior to accepting or entering the offer to a sponsor? For examination purposes, the Examiner will interpret this to mean that the promotion code is provided prior to the use of the code.
6. Claims 19 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

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which applicant regards as the invention. Claims 19 and 23 use "means for" language and disclosure paragraph 0028 indicates a desire for this language to invoke 35 USC § 12, sixth paragraph, as a means-plus-function interpretation, however, in order to properly invoke 35 USC § 12, sixth paragraph, the disclosure must define the structures or materials, and equivalents, associated with that function. Please see MPEP § 2106(II)(C). The Examiner notes that there is no express, implied, or inherent definition to the functions associated with the "means for" language of these claims, therefore 35 USC § 12, sixth paragraph, is not invoked. For examination purposes, the Examiner will interpret this to mean that any structure that may perform the respective function is equivalent.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 10-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent, a method/process claim must 1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or

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materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter.

As to claim 10, it claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing. Claim 10 recites steps of inputting, accessing, associating, constructing, and transmitting, however, inputting, accessing and transmitting are extra-solution activities that do not tie a method to a particular machine or apparatus, and the associating and constructing steps are not positively recited as performed by the machine or apparatus (here, a mobile phone). Therefore, the method is not tied to the machine or apparatus, and since no transformation of matter is occurring, claim 10 is directed to non-statutory subject matter.

Claims 11-18 depend from claim 10, but do not resolve the above issue; therefore these claims are also directed to non-statutory subject matter.

The Examiner suggests, in order to rectify this issue, amending claim 10 to indicate (assuming that it is within the inventors original conception, and that there is disclosure support) that the mobile phone is performing the associating and/or the constructing - preferably automatically performed by the phone, but certainly NOT

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performed by a user of the phone. In explanation: if the user could be performing those steps, then the device (phone) is considered a general purpose device that is no different from other devices, therefore the method is not tied to that particular device.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 4-5, 7, 10, 13-14, 16, 19, 22-23, and 25 are rejected under 35

U.S.C. 102(a) and (e) as being anticipated by Barenbaum et al. (U.S. Patent Application Publication No. 2001/0039514, hereafter Barenbaum).

Please note that, as a convenience to applicant, the Examiner has pointed out, by **bolding**, optional or intended use language, and included a note as to the ramifications of such language below.

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Claim 1: Barenbaum discloses a mobile phone having a software application for participating in a promotional offer, said mobile phone comprising:

a processor (paragraph 0042, display the identifier; the Examiner notes that there must be a processor in order to direct the retaining and displaying; citation hereafter by number only);

a processor readable storage medium (0042, display the identifier; the Examiner notes that there must be storage in order to retain for display);

code recorded in the processor readable storage medium to input a promotional offer code into the mobile phone (0010, 0037, digital deal code);

code recorded in the processor readable storage medium to access promotional offer code data that has been pre-provisioned in the mobile phone (0010, address; 0034, register and other specific data and mobile number; 0035, input data provided);

code recorded in the processor readable storage medium to associate an input promotional offer code with corresponding promotional offer code data (0034, enable communication; 0037, communicate code to receive incentive);

code recorded in the processor readable storage medium to construct a promotional offer entry based on promotional offer code data that corresponds to a promotional offer code (0037, 0026); and

code recorded in the processor readable storage medium to transmit the promotional offer entry to a promotional sponsor (0037).

Claim 4: Barenbaum discloses the mobile phone of claim 1 wherein the promotional offer code data defines the format and content of a promotional offer entry (0037).

Claim 5: Barenbaum discloses the mobile phone of claim 4 wherein the code recorded in the processor readable storage medium to construct a specific promotional offer entry comprises:

code recorded in the processor readable storage medium to create a message addressed to the promotional sponsor in the format described by the promotional offer code data (0037, 0039); and

code recorded in the processor readable storage medium to include the content described by the promotional offer code data in the message (0037, 0039; the Examiner understands that the digital deal code being sent back with the entry is all the format and content required for valid entry).

Claim 7: Barenbaum discloses the mobile phone of claim 5 wherein the format of the promotional offer entry described by the promotional offer code data is an SMS message (0037, short messaging service).

Claim 10: Barenbaum discloses a method by which a mobile phone can participate in a promotional offer, said method comprising:

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inputting a promotional offer code into the mobile phone (0010, 0037, digital deal code);

accessing promotional offer code data that has been pre-provisioned in the mobile phone (0010, address; 0034, register and other specific data and mobile number; 0035, input data provided);

associating an input promotional offer code with corresponding promotional offer code data (0034, enable communication; 0037, communicate code to receive incentive);

constructing a promotional offer entry based on promotional offer code data that corresponds to a promotional offer code (0037, 0026); and

transmitting the promotional offer entry to a promotional sponsor (0037).

Claim 13: Barenbaum discloses the method of claim 10 wherein the promotional offer code data defines the format and content of a promotional offer entry (0037).

Claim 14: Barenbaum discloses the method of claim 13 wherein constructing a specific promotional offer entry comprises:

creating a message addressed to the promotional sponsor in the format described by the promotional offer code data (0037, 0039); and

including the content described by the promotional offer code data in the message (0037, 0039; the Examiner understands that the digital deal code being sent back with the entry is all the format and content required for valid entry).

Claim 16: Barenbaum discloses the method of claim 14 wherein the format of the promotional offer entry described by the promotional offer code data is an SMS message (0037, short messaging service).

Claim 19: Barenbaum discloses a mobile phone for participating in a promotional offer, said mobile phone comprising:

means for inputting a promotional offer code into the mobile phone (0010, 0037, digital deal code);

means for accessing promotional offer code data that has been pre-provisioned in the mobile phone (0010, address; 0034, register and other specific data and mobile number; 0035, input data provided);

means for associating an input promotional offer code with corresponding promotional offer code data (0034, enable communication; 0037, communicate code to receive incentive);

means for constructing a promotional offer entry based on promotional offer code data that corresponds to a promotional offer code (0037, 0026); and

means for transmitting the promotional offer entry to a promotional sponsor (0037).

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Claim 22: Barenbaum discloses the mobile phone of claim 19 wherein the promotional offer code data defines the format and content of a promotional offer entry (0037).

Claim 23: Barenbaum discloses the mobile phone of claim 22 wherein constructing a specific promotional offer entry comprises:

means for creating a message addressed to the promotional sponsor in the format described by the promotional offer code data (0037, 0039); and

means for including the content described by the promotional offer code data in the message (0037, 0039; the Examiner understands that the digital deal code being sent back with the entry is all the format and content required for valid entry).

Claim 25: Barenbaum discloses the mobile phone of claim 23 wherein the format of the promotional offer entry described by the promotional offer code data is an SMS message (0037, short messaging service).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 2-3, 6, 8-9, 11-12, 15, 17-18, 20-21, 24, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barenbaum.

Claim 2: Barenbaum discloses the mobile phone of claim 1 wherein the pre-provisioned promotional offer code data that resides in the mobile phone was sent to the mobile phone via an over-the-air (OTA) process. Barenbaum, however, teaches providing device address (0010), mobile numbers (0034), and client input data (0035) as identifiers, and the Examiner understands that the address and numbers are generally flashed or placed in memory when the phone is activated, and the client input data would generally be part of the initial offer information sent via wireless communication to the user. The Examiner understands that providing the promotional offer code data via an OTA process or manufacturer embedding are each one of but a limited number of predictable ways to provide the data to the mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the client input data of Barenbaum in order to provide the data to the mobile phone via an OTA process.

The rationale for combining in this manner is that OTA provision is one of a limited number of predictable ways of providing the promotion offer code data to the mobile phone.

Claim 3: Barenbaum discloses the mobile phone of claim 1, but does not explicitly disclose wherein the pre-provisioned promotional offer code data that resides in the mobile phone was embedded into the mobile phone by the manufacturer. Barenbaum, however, teaches providing device address (0010), mobile numbers (0034), and client input data (0035) as identifiers, and the Examiner understands that the address and numbers are generally flashed or placed in memory when the phone is activated, and the client input data would generally be part of the initial offer information sent via wireless communication to the user. The Examiner understands that providing the promotional offer code data via an OTA process or manufacturer embedding are each one of but a limited number of predictable ways to provide the data to the mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the client input data of Barenbaum in order to provide the data to the mobile phone via a manufacturer embedding process.

The rationale for combining in this manner is that manufacturer embedding is one of a limited number of predictable ways of providing the promotion offer code data to the mobile phone.

Claim 6: Barenbaum discloses the mobile phone of claim 5, but does not explicitly disclose wherein the code recorded in the processor readable storage medium to construct a specific promotional offer entry further comprises: code

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recorded in the processor readable storage medium to encrypt the message.

Barenbaum, however, teaches assigning a unique identifier or authorization code to each digital deal in order to track and verify the deals (0039). The Examiner understands encrypting to be a means of verification and assuring privacy, therefore it is a design choice as whether to encrypt and/or to use unique identifiers to either assure privacy or verify identities or deals offered.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the unique identifier and authorization code of Barenbaum in order to encrypt the promotional offer entry message.

The rationale for combining in this manner is that using encryption is a design choice regarding verification and privacy.

Claim 8: Barenbaum discloses the mobile phone of claim 5, but does not explicitly disclose wherein the format of the promotional offer entry described by the promotional offer code data is an MMS message. Barenbaum, however, teaches text and short message service entry (0037), responses that may include logos (0028, 0042) and bar codes (0039), and email alerts (0023) as communication types. The Examiner understands that SMS, MMS and e-mail are each one of but a limited number of ways to accomplish communication via a mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the mobile phone promotional offer of Barenbaum with

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the various types of communications of Barenbaum in order to provide the promotional offer entry to be an MMS message.

The rationale for combining in this manner is that MMS is but one of a limited number of predictable types of communication when using a mobile phone.

Claim 9: Barenbaum discloses the mobile phone of claim 5, but does not explicitly disclose wherein the format of the promotional offer entry described by the promotional offer code data is an e-mail message. Barenbaum, however, teaches text and short message service entry (0037), responses that may include logos (0028, 0042) and bar codes (0039), and email alerts (0023) as communication types. The Examiner understands that SMS, MMS and e-mail are each one of but a limited number of ways to accomplish communication via a mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the mobile phone promotional offer of Barenbaum with the various types of communications of Barenbaum in order to provide the promotional offer entry to be an e-mail message.

The rationale for combining in this manner is that e-mail is but one of a limited number of predictable types of communication when using a mobile phone.

Claim 11: Barenbaum discloses the method of claim 10, but does not explicitly disclose wherein the pre-provisioned promotional offer code data that resides in the mobile phone was sent to the mobile phone via an over-the-air (OTA) process.

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Barenbaum, however, teaches providing device address (0010), mobile numbers (0034), and client input data (0035) as identifiers, and the Examiner understands that the address and numbers are generally flashed or placed in memory when the phone is activated, and the client input data would generally be part of the initial offer information sent via wireless communication to the user. The Examiner understands that providing the promotional offer code data via an OTA process or manufacturer embedding are each one of but a limited number of predictable ways to provide the data to the mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the client input data of Barenbaum in order to provide the data to the mobile phone via an OTA process.

The rationale for combining in this manner is that OTA provision is one of a limited number of predictable ways of providing the promotion offer code data to the mobile phone.

Claim 12: Barenbaum discloses the method of claim 10, but does not explicitly disclose wherein the pre-provisioned promotional offer code data that resides in the mobile phone was embedded into the mobile phone by the manufacturer.

Barenbaum, however, teaches providing device address (0010), mobile numbers (0034), and client input data (0035) as identifiers, and the Examiner understands that the address and numbers are generally flashed or placed in memory when the

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phone is activated, and the client input data would generally be part of the initial offer information sent via wireless communication to the user. The Examiner understands that providing the promotional offer code data via an OTA process or manufacturer embedding are each one of but a limited number of predictable ways to provide the data to the mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the client input data of Barenbaum in order to provide the data to the mobile phone via a manufacturer embedding process.

The rationale for combining in this manner is that manufacturer embedding is one of a limited number of predictable ways of providing the promotion offer code data to the mobile phone.

Claim 15: Barenbaum discloses the mobile phone of claim 14 wherein constructing a specific promotional offer entry further comprises encrypting the message. Barenbaum, however, teaches assigning a unique identifier or authorization code to each digital deal in order to track and verify the deals (0039). The Examiner understands encrypting to be a means of verification and assuring privacy, therefore it is a design choice as whether to encrypt and/or to use unique identifiers to either assure privacy or verify identities or deals offered.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the unique

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identifier and authorization code of Barenbaum in order to encrypt the promotional offer entry message.

The rationale for combining in this manner is that using encryption is a design choice regarding verification and privacy.

Claim 17: Barenbaum discloses the method of claim 14, but does not explicitly disclose wherein the format of the promotional offer entry described by the promotional offer code data is an MMS message. Barenbaum, however, teaches text and short message service entry (0037), responses that may include logos (0028, 0042) and bar codes (0039), and email alerts (0023) as communication types. The Examiner understands that SMS, MMS and e-mail are each one of but a limited number of ways to accomplish communication via a mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the mobile phone promotional offer of Barenbaum with the various types of communications of Barenbaum in order to provide the promotional offer entry to be an MMS message.

The rationale for combining in this manner is that MMS is but one of a limited number of predictable types of communication when using a mobile phone.

Claim 18: Barenbaum discloses the method of claim 14, but does not explicitly disclose wherein the format of the promotional offer entry described by the promotional offer code data is an e-mail message. Barenbaum, however, teaches

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text and short message service entry (0037), responses that may include logos (0028, 0042) and bar codes (0039), and email alerts (0023) as communication types. The Examiner understands that SMS, MMS and e-mail are each one of but a limited number of ways to accomplish communication via a mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the mobile phone promotional offer of Barenbaum with the various types of communications of Barenbaum in order to provide the promotional offer entry to be an e-mail message.

The rationale for combining in this manner is that e-mail is but one of a limited number of predictable types of communication when using a mobile phone.

Claim 20: Barenbaum discloses the mobile phone of claim 19, but does not explicitly disclose wherein the pre-provisioned promotional offer code data that resides in the mobile phone was sent to the mobile phone via an over-the-air (OTA) process. Barenbaum, however, teaches providing device address (0010), mobile numbers (0034), and client input data (0035) as identifiers, and the Examiner understands that the address and numbers are generally flashed or placed in memory when the phone is activated, and the client input data would generally be part of the initial offer information sent via wireless communication to the user. The Examiner understands that providing the promotional offer code data via an OTA process or manufacturer embedding are each one of but a limited number of predictable ways to provide the data to the mobile phone.

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Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the client input data of Barenbaum in order to provide the data to the mobile phone via an OTA process.

The rationale for combining in this manner is that OTA provision is one of a limited number of predictable ways of providing the promotion offer code data to the mobile phone.

Claim 21: Barenbaum discloses the mobile phone of claim 19, but does not explicitly disclose wherein the pre-provisioned promotional offer code data that resides in the mobile phone was embedded into the mobile phone by the manufacturer. Barenbaum, however, teaches providing device address (0010), mobile numbers (0034), and client input data (0035) as identifiers, and the Examiner understands that the address and numbers are generally flashed or placed in memory when the phone is activated, and the client input data would generally be part of the initial offer information sent via wireless communication to the user. The Examiner understands that providing the promotional offer code data via an OTA process or manufacturer embedding are each one of but a limited number of predictable ways to provide the data to the mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the client

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input data of Barenbaum in order to provide the data to the mobile phone via a manufacturer embedding process.

The rationale for combining in this manner is that manufacturer embedding is one of a limited number of predictable ways of providing the promotion offer code data to the mobile phone.

Claim 24: Barenbaum discloses the mobile phone of claim 23, but does not explicitly disclose wherein constructing a specific promotional offer entry further comprises encrypting the message. Barenbaum, however, teaches assigning a unique identifier or authorization code to each digital deal in order to track and verify the deals (0039). The Examiner understands encrypting to be a means of verification and assuring privacy, therefore it is a design choice as whether to encrypt and/or to use unique identifiers to either assure privacy or verify identities or deals offered.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the unique identifier and authorization code of Barenbaum in order to encrypt the promotional offer entry message.

The rationale for combining in this manner is that using encryption is a design choice regarding verification and privacy.

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Claim 26: Barenbaum discloses the mobile phone of claim 23, but does not explicitly disclose wherein the format of the promotional offer entry described by the promotional offer code data is an MMS message. Barenbaum, however, teaches text and short message service entry (0037), responses that may include logos (0028, 0042) and bar codes (0039), and email alerts (0023) as communication types. The Examiner understands that SMS, MMS and e-mail are each one of but a limited number of ways to accomplish communication via a mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the mobile phone promotional offer of Barenbaum with the various types of communications of Barenbaum in order to provide the promotional offer entry to be an MMS message.

The rationale for combining in this manner is that MMS is but one of a limited number of predictable types of communication when using a mobile phone.

Claim 27: Barenbaum discloses the mobile phone of claim 23, but does not explicitly disclose wherein the format of the promotional offer entry described by the promotional offer code data is an e-mail message. Barenbaum, however, teaches text and short message service entry (0037), responses that may include logos (0028, 0042) and bar codes (0039), and email alerts (0023) as communication types. The Examiner understands that SMS, MMS and e-mail are each one of but a limited number of ways to accomplish communication via a mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the mobile phone promotional offer of Barenbaum with the various types of communications of Barenbaum in order to provide the promotional offer entry to be an e-mail message.

The rationale for combining in this manner is that e-mail is but one of a limited number of predictable types of communication when using a mobile phone.

10. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, it meets the claim. See *e.g. In re Collier*, 158 USPQ 266, 267 (CCPA 1968) (where the court interpreted the claimed phrase “a connector member for engaging shield means” and held that the shield means was not a positive element of the claim since “[t]here is no positive inclusion of ‘shield means’ in what is apparently intended to be a claim to structure consisting of a combination of elements” and where the court interpreted the claimed phrase “said ferrule-forming member being crimpable onto said shield means” and held that the shield means was not a positive element of the claim since “[t]here is no positive inclusion of ‘shield means’ in what is apparently intended to be a claim to structure consisting of a combination of elements.... “[t]he ferrule or connector member is crimpable but not required, structurally, to be crimped These cannot be regarded as structural limitations and therefore not as positive limitations in a

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claim directed to structure. They cannot therefore be relied on to distinguish from the prior art.”)

11. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT D. GARTLAND whose telephone number is (571)270-5501. The examiner can normally be reached on 7:30-6:00 EST Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/S. D. G./
Examiner, Art Unit 3622

/J. V./
Examiner, Art Unit 3622

/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622